

REMARKS

I. Introduction

With the addition of new claims 28 and 29, claims 23 to 25 and 27 to 29 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to Claim 25

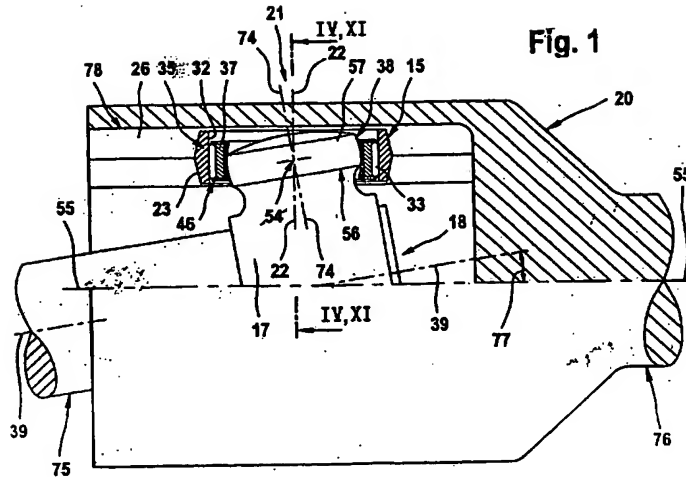
As regards the objection to claim 25, while Applicants do not necessarily agree with the merits of this objection, to facilitate matters, claim 25 has been amended herein without prejudice as suggested, thereby obviating the present objection. Withdrawal of this objection is therefore respectfully requested.

III. Rejection of Claims 23, 25 and 27 Under 35 U.S.C. § 112, First Paragraph

As regards the rejection of claims 23, 25 and 27 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement, the Specification is replete with references to ball head 56, and ball head 56 is shown throughout the Figures. Thus, the allegation that "[t]he ball joint 38 . . . is not described as having 'ball heads', nor is there any suggestion that it would include ball heads" is plainly without merit. In this regard, the present claims relate to a **tripod joint**, which necessarily has multiple ball heads.

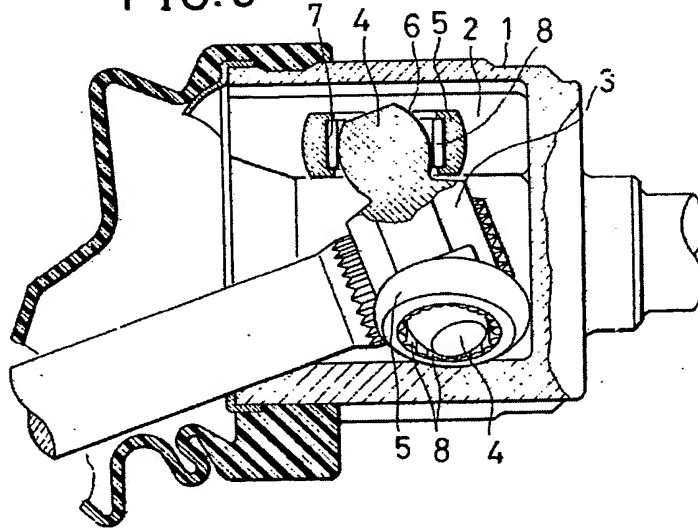
In addition, the publication of the present application, U.S. Patent Application Publication No. 2005/0003896, and U.S. Patent No. 6,682,433, which issued from the parent application, U.S. Patent Application Serial No. 09/824,983, are classified under Class 464 ("Rotary Shafts, Gudgeons, Housings, and Flexible Couplings for Rotary Shafts"), Subclass 111 ("Coupling Accommodates Drive Between Members Having Misaligned or Angularly Related Axes -- **Tripod Joint**"). Thus, the Office, in classifying the present application and its parent application, apparently recognized that the present application and its parent application relate to **tripod joints**, which necessarily have multiple ball heads.

Furthermore, any review of Figure 1, reproduced below, by one of ordinary skill in the art would lead to the conclusion that multiple ball heads 56 are provided.

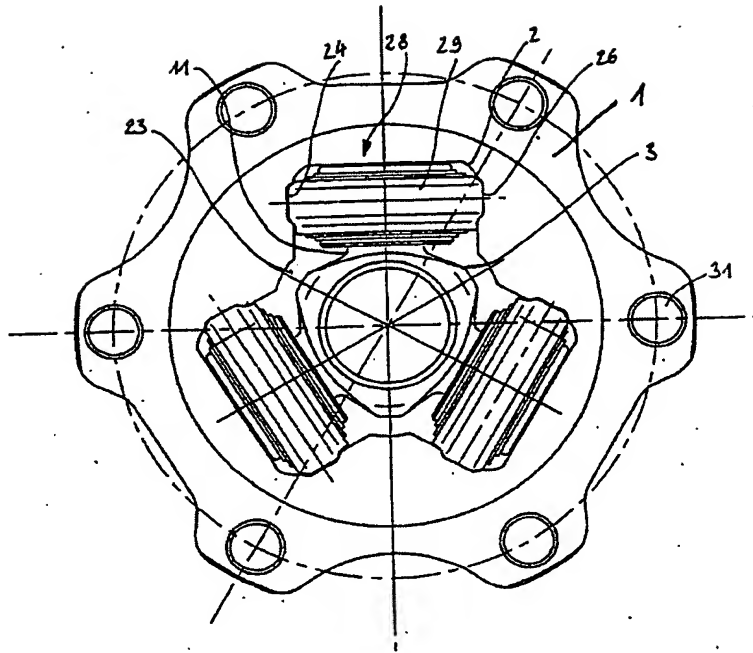


Moreover, the two foreign patent documents referred to in the Specification relate to tripod joints having multiple heads. In this regard, German Published Patent Application No. 28 31 044, referred to on page 1, lines 13 to 31 of the Specification, describes a tripod joint having multiple pods 4 as illustrated, for example, in Figure 3 reproduced below:

FIG. 3



European Published Patent Application No. 0 426 186, referred to on page 1, line 32 to page 2, line 16 of the Specification, also describes a tripod joint having multiple pivot heads 5 as illustrated, for example, in Figure 5 reproduced below:



Thus, it is respectfully submitted that a person of ordinary skill in the art would immediately recognize that multiple ball heads 56 are provided in the tripod joint of the present application. As such, it is respectfully submitted that the application as filed, including the Specification, claims and drawings, readily conveys with reasonable clarity to those skilled in the art that, as of the effective filing date of the present application, *i.e.*, the April 3, 2001 filing date of the parent application, the Applicants hereof were in possession of the subject matter claimed. As such, it is respectfully submitted that the written description requirement of 35 U.S.C. § 112, first paragraph is fully satisfied. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997) (an applicant can show possession of the subject matter claimed by describing the claimed subject matter with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed subject matter). Moreover, that which is conventional or well known to one of ordinary skill in the art, such as a tripod joint having multiple heads or pods, need not be disclosed in detail. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986); Capon v. Eshhar, 418 F.3d 1349, 1357, 76 U.S.P.Q.2d 1078, 1085 (Fed. Cir. 2005) ("The 'written description' requirement must be applied in the context of the particular invention and the state of the knowledge. . . . As each field evolves, the

balance also evolves between what is known and what is added by each inventive contribution.”). If a skilled artisan would have understood an inventor to be in possession of the claimed subject matter at the time of filing, even if every nuance in the claims is not explicitly described in the specification, then the adequate written description requirement is met. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 U.S.P.Q.2d 111, 116 (Fed. Cir. 1991).

In view of all of the foregoing, it is respectfully submitted that the present claims fully comply with the written description requirement under 35 U.S.C. § 112, first paragraph, and withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 23, 25 and 27 Under 35 U.S.C. § 112, Second Paragraph

As regards the rejection of claims 23, 25 and 27 under 35 U.S.C. § 112, second paragraph, the Examiner will note that claims 23 and 27 have been amended herein without prejudice to change “each ball body” to --each ball head--, thereby obviating the present rejection. In view of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 23, 25 and 27 Under 35 U.S.C. § 103(a)

Claims 23, 25 and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,199,925 (“Welschof”) and U.S. Patent No. 2,670,975 (“Schwabe”). It is respectfully submitted that the combination of Welschof and Schwabe does not render unpatentable the present claims for at least the following reasons.

The Final Office Action contends that Schwabe discloses that an inner ring with a recess including a cylindrical hole having two securing rings radially extending from two spaced apart grooves is a functional equivalent of a ring with a spherical recess. While Applicants do not necessarily agree with this contention. Even if this statement was accurate -- which is not necessarily conceded -- there is no motivation or suggestion to combine Welschof and Schwabe as proposed in the Final Office Action as there must be in order to reject claims as unpatentable over this combination. In this regard, Welschof describes with reference to Figure 2 an arrangement of flat portions of an intermediate element 12 that face flat surfaces 16, 17 of a head portion 9 such that the intermediate element is able to articulate in the

sense of tilting or pivoting on the head portion **but is not able to rotate completely thereabout**. Col. 3, lines 9 to 19. With reference to Figure 4, Welschof describes an arrangement in which a pair of lugs 19 prevent an intermediate piece from rotating about an arm to reach a position in which the intermediate element can be removed from the arm. Col. 3, lines 38 to 68. In stark contrast, Schwabe states that its object is to provide an articulation joint that allegedly provides “**easier assembling and dismantling than has been possible hitherto with ball joints**.” Co. 1, lines 6 to 10 (emphasis added). In order to achieve this ease of assembly and dismantling, a linkage is provided that incorporates articulation joints which can be assembled and dismantled “without any tools **simply by turning one of two associated components of the linkage about its longitudinal axis approximately a quarter turn from its operative position**,” col. 1, lines 15 to 21 (emphasis added), the **exact** type of movement that Welschof states is prevented to thereby prevent disassembly of the ball joint. Thus, Welschof plainly teaches away from the proposed combination with Schwabe, and Schwabe plainly teaches away from the proposed combination with Welschof. As such, there is no motivation to make the proposed combination.

Moreover, the proposed modification would render the device described by Welschof unsatisfactory for its intended purpose and/or change the principle of operation of the device described by Welschof. As such, there is no motivation to make the proposed modification for this additional reason. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (there is no suggestion or motivation to make a proposed modification if the proposed modification would render the prior art device being modified unsatisfactory for its intended purpose); In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959) (the disclosures of references are not sufficient to render claims prima facie obvious if the proposed modification or combination would change the principle of operation of the prior art device being modified).

Simply put, there is no suggestion or motivation for making the proposed combination as there must for a prima facie case of obviousness. Thus, it is respectfully submitted that the proposed combination of Welschof and Schwabe does not render unpatentable the present claims.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. New Claims 28 and 29

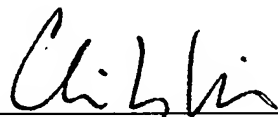
New claims 28 and 29 have been added herein. It is respectfully submitted that claims 28 and 29 are fully supported by the present application, including the Specification. Since claim 28 includes features analogous to claim 23 and claim 29 includes features analogous to claim 27, it is respectfully submitted that claims 28 and 29 are patentable over the references relied upon for at least the reasons more fully set forth above.

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: Feb. 28, 2007

By: 
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646